

REMARKS

Reconsideration and allowance in view of the foregoing amendments and the following remarks are respectfully requested. Claims 1-25, 27-30, 33-48, 52-53, and 55 are pending. Favorable consideration is requested.

I. Objections to the Specification and Claims

The Applicant hereby submits a revised Abstract of the Disclosure to overcome the objection thereto. Further, Claims 26 and 49 have been canceled without prejudice or disclaimer. Thus, the outstanding objections to the specification and claims, respectively, should be withdrawn.

II. The Applicant's Response to the "Response to Arguments"

The outstanding rejections under 35 U.S.C. §102(e) and 35 U.S.C. §103(a), which are rebutted below, are *verbatim* presentations of the rejections provided in the previous Office Action of December 19, 2003. In response to the rejections, the Applicant submitted the arguments, which are substantively re-presented below in items II and IV, in the Amendment of March 2, 2004. Thus, the "Response to Arguments," which begin on page 12 of the outstanding Office Action, provide the only differences between the previous Office Action of December 19, 2003, and the outstanding Office Action of May 19, 2004, with regard to the rejections over the cited references.

More specifically, in responding to the arguments submitted by the Applicant in the Amendment of March 2, 2004, the Response to Arguments counters the Applicant's arguments of March 2, 2004, by stating, in part, "If the

prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).”

However, both *In re Casey* and *In re Otto* are wrongly applied to the presently rejected claims. Specifically, *In re Casey* is discussed in MPEP §2115 as part of a “line of cases [that] is limited to claims directed to machinery which works upon an article or material in its intended use.” Further, the intended use discussed in *In re Otto* is stated in the preamble, and not in the body of the claims (see MPEP §2111.02). It is respectfully submitted that none of Claims 1, 27, or 55, which are specifically mentioned in the Response to Arguments, are directed to machinery nor are any of the relevant features of Claims 1, 27, or 55 recited in the respective preambles. Thus, the case law in the Response to Arguments is misapplied, and is therefore insufficient to overcome the Applicant’s arguments with regard to the cited references.

III. The Rejection Under 35 U.S.C. §102(e)

As in the previous Office Action of December 19, 2003, Claims 1-4, 6-8, 12-14, 26-30, 33-38, 49, and 55 were again rejected under 35 U.S.C. §102(e) as being anticipated by Starr (U.S. Patent 6,606,606; hereafter “Starr”). The Applicant respectfully maintains its traversal of this rejection, and further maintains its request that this rejection be reconsidered and withdrawn.

Starr describes the management of plural financial accounts to perform plural financial transactions, with each transaction involving multiple sub-transactions among multiple financial service providers (Starr, col. 2, lines 52-57).

The description of such management system does not teach, or even suggest, the presently rejected claims.

In MPEP §2131, it is stated that, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Applicant submits that this standard is not met by Starr, relative to the rejected claims.

Starr is fundamentally deficient in view of features recited in independent Claims 1, 27, and 55. For example, **Claim 1** recites a data network comprising a data server that includes a financial transaction manager, which is neither taught nor suggested by Starr. In particular, the financial transaction manager “is also to issue an instruction to have a check issued that includes an offer to receive future funds via an electronic financial account.” The financial service center recited in **Claim 27** includes a financial transaction manager that “causes a check to be printed and sent to another at the request of a user, and wherein the check includes an offer to receive future funds via an electronic account at the financial service center.” Further still, **Claim 55** recites an apparatus having a process to, in part, implement a financial transaction manager that issues checks, “wherein each of the checks includes an offer to receive future funds via an electronic financial account.” None of these features are taught by Starr.

Rather, Starr describes a user interface that allows a subscriber to control a payroll operation as follows:

...the server 14 can create instructions that can be followed by the different financial service providers

that have a role in the payroll financial transaction.... The server can then instruct the payroll service provider to deliver paychecks in the appropriate amounts to the small business for distribution to the employees. Thus by activating one control, the subscriber is able to perform the multiple financial transaction involved in the payroll process (Starr, col. 4, lines 32-48).

The systems and methods described by Starr, summarized to “perform the middle-level computing and processing that negotiates the financial transactions which are to occur through each of the service providers in order to perform this compound financial transaction,” (Starr, col. 3, lines 5-9) do not include any teaching of the features of independent Claims 1, 27, and 55, set forth above.

Therefore, for at least the above reasons, it is respectfully submitted that Starr does not anticipate independent Claims 1, 27, and 55. Further, in view of the dependence of the remainder of **Claims 2-4, 6-8, 12-14, 26, 28-30, 33-38, and 49** from either of Claims 1 and 27, it is further submitted that none of the presently rejected claims are anticipated by Starr. Thus, the rejection under 35 U.S.C. §102(e) should be withdrawn.

IV. The Rejections Under 35 U.S.C. §103(a)

In the Office Action, the following rejections have been made under 35 U.S.C. §103(a):

- a) Claim 5 was rejected under 35 U.S.C. §103(a) over Starr;
- b) Claims 9-11 were rejected under 35 U.S.C. §103(a) over Starr in view of Schrader, et al. (U.S. Patent 5,903,881; hereafter Schrader);

c) Claims 15-22, 39-45, 52, and 53 were rejected under 35 U.S.C. §103(a) over Starr in view of O'Leary, et al. (U.S. Patent 6,609,113);

d) Claims 23-25 and 46-48 were rejected under 35 U.S.C. §103(a) over Starr and O'Leary and Schrader.

The above-identified rejections a) through d) were originally presented in the previous Office Action of December 19, 2003, and appear to be a *verbatim* presentation of the rejections. Therefore, in view of the arguments presented above in item II, and in further view of at least the arguments that were presented in the Applicant's previous Response of March 2, 2004 (repeated below), the Applicant respectfully traverses all of the outstanding rejections under 35 U.S.C. §103(a), and further requests that these rejections be reconsidered and withdrawn.

a) **Claim 5** depends from Claim 1, and is therefore distinguishable over Starr for at least the reasons set forth above regarding Claim 1. No further points of rejection have been provided in the present rejection to compensate for the aforementioned deficiencies of Starr with regard to Claim 1.

b) **Claims 9-11** depend, indirectly, from Claim 1. Therefore Claims 9-11 are distinguishable over Starr for at least the reasons set forth above regarding Claim 1. Schrader does not compensate for such deficiencies, nor is that assertion made in the rejection.

In the rejection, the features that are acknowledged to not be explicitly disclosed by Starr include all of those recited in Claims 9-11. Further, neither the historical backdrop of on-line banking provided in the Background (Schrader, col. 1, line 5 through col. 5, line 57) nor the Summary (col. 5, line 60 through col. 7, line 14), which were cited in the rejection, teaches or suggests the features of Claims 9-11.

Instead, the Background in Schrader surmises that “it is desirable to provide on an online banking software product and system that tightly integrates bill payment, account management, and determination of current balances, into a single user interface display,” (col. 5, lines 53-57). The Summary summarizes the disclosure as, “The integration and simultaneous presentation of the three different types of transactions, and two account balances in a single user interface presents a complete view of both financial institutional data (cleared transactions, and cleared balance) and customer data (transaction instructions, uncleared transactions and combined balance) on one screen,” (col. 6, lines 38-44). The descriptions provided by Schrader do not describe the participants of a transaction as they are recited in Claims 9-11.

c) **Claims 15-22** depend, directly or indirectly, from Claim 1, and therefore are distinguishable over Starr for at least the reasons set forth above regarding Claim 1. Similarly, **Claims 39-45** depend, directly or indirectly, from Claim 27, and therefore are distinguishable over Starr for at least the reasons set forth above regarding Claim 27. O’Leary does not compensate for such deficiencies, nor is that assertion made in the rejection.

The rejection acknowledges the deficiencies of Starr with regard to all of the features recited in **Claim 15-22 and 39-45**. Therefore, the rejection purports to append the teachings of O’Leary onto a base claim and intervening claims, which the rejection acknowledges are not taught by Starr. Further, the rejection does not provide any suggestion of the desirability of doing what is done by the rejected claims, other than to say that O’Leary performs steps that Starr does not. Thus, the rejection fails to meet the required burden set forth in MPEP §2143. Therefore, it is respectfully submitted that Claims 15-22 and 39-45 are not obvious over the proposed combination of Starr and O’Leary.

The method of **Claim 52** comprises, in part, “including on the check an offer to receive future funds via an electronic financial account with a pre-printed unique access code for the account.” The method of Claim 53 comprises, in part, “issuing a physical check...wherein the check includes an offer to utilize an account created within the electronic financial network and associated with the requesting participant to receive future funds.” The Applicant respectfully submits that Claims 52 and 53 are distinguishable over Starr for at least the reasons set forth above regarding Claims 1 and 27. O’Leary does not compensate for such deficiencies, nor is that assertion made in the rejection.

d) Claims **23-25** depend, directly or indirectly, from Claim 1, and therefore are distinguishable over Starr for at least the reasons set forth above regarding Claim 1. Similarly, Claims **46-48** depend, directly or indirectly, from Claim 27, and therefore are distinguishable over Starr for at least the reasons set forth above regarding Claim 27. Neither O’Leary nor Schrader compensates for

such deficiencies, nor is that assertion made in the rejection. Further, the rejection does not provide any suggestion of the desirability of doing what is done by the rejected claims, other than to say that O'Leary and Schrader are able to accomplish what Starr is unable to. Thus, the rejection fails to meet the required burden set forth in MPEP §2143.

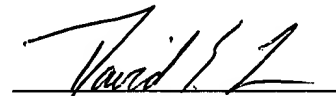
V. CONCLUSION

All objections and rejections having been addressed, it is respectfully submitted that the present application is now in condition for allowance. Early and forthright issuance of a Notice of Allowability is earnestly solicited.

Respectfully Submitted,

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